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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,118	11/12/2003	Stephen C. Macevitz	55525-8045.US01	8171
22918	7590	04/25/2006	EXAMINER	
PERKINS COIE LLP			LU, FRANK WEI MIN	
P.O. BOX 2168			ART UNIT	
MENLO PARK, CA 94026			PAPER NUMBER	

1634

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,118	<b>Applicant(s)</b> MACEVICZ, STEPHEN C.	
	<b>Examiner</b> Frank W Lu	<b>Art Unit</b> 1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/2/2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's response to the office action filed on February 2, 2006 has been entered. The claims pending in this application are claims 28-31. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of the response filed on February 2, 2006. Note that the amendments filed on February 2, 2006, which contain claims 23-27, do not correspond to the amendments filed on September 3, 2004 wherein claims 23-27 have been canceled.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 28 is rejected as vague and indefinite. According to the first part of the first "wherein" phrase of the claim, said first end segment consists of a first end sequence, having 5 to 12 basepairs, immediately adjacent to a cleaved restriction site and said second end segment consists of a second end sequence, having 5 to 12 basepairs, immediately adjacent to a cleaved restriction site, if the first end sequence is located on 5' end of the oligonucleotide while the second end sequence is located on 3' end of the oligonucleotide, the first part of the first "wherein" phrase indicates that the first end sequence must separated from the second end

sequence by one or two cleaved restriction sites and the first end sequence cannot directly connect with the second end sequence. However, according to the second part of the first “wherein” phrase of the claim, said first end sequence and said second end sequence are ligated directly together. Therefore, it appears that the first part of the first “wherein” phrase and the second part of the first “wherein” phrase do not correspond each other. Please clarify.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by New England Biolabs 96/97 Catalog (pages 36, 50, 108 and 109).

Note that this rejection is made in view of the ambiguity of claim 28 (see above rejection under 35 USC 112, second paragraph). Since, from claim 28, it is unclear whether the first end sequence is located on 5’ or 3’ end of the oligonucleotide while the second end sequence is located on 3’ or 5’ end of the oligonucleotide, the rejection below is based on that the first end sequence is not located on 5’ or 3’ end of the oligonucleotide while the second end sequence is not located on 3’ or 5’ end of the oligonucleotide.

Regarding claim 28, New England Biolabs 96/97 Catalog teaches a pBR322 Pst I site primer (#1240) (see page 109). Since this pBR322 Pst I site primer taught by New England Biolabs 96/97 Catalog is 30 bases in length and contains two restriction sites wherein ATT is the

Art Unit: 1634

cleaved site of Ssp I and GTT is the cleaved site of HpaI, and 2.0 A<sub>260</sub> unit of the pBR322 Pst I site primer must contain more than one identical primers (see pages 36, 50, and 109), this catalog discloses that a plurality of oligonucleotides (ie., more than one identical pBR322 Pst I site primers), each said oligonucleotide containing first and second end segments from opposite ends of one such fragment wherein said first end segment consists of a first end sequence (ie., GTTGCCGGAAG), having 5 to 12 basepairs, immediately adjacent to a cleaved restriction site (ie., ATT, a cleaved Ssp I site), said second end segment consists of a second end sequence (ie., CTAGAGTAAGTA), having 5 to 12 basepairs immediately adjacent to a cleaved restriction site (ie., GTT, a cleaved Hpa I site), and said first and second end sequences are directly ligated together wherein each end sequence contains the same number of basepairs (ie., 12 bp) and wherein each end sequence in the plurality of oligonucleotides is unique as recited in claim 28. Although this catalog does not teach that a plurality of oligonucleotides are derived from restriction fragments of a polynucleotide wherein each said oligonucleotide contains first and second end segments from opposite ends of one such restriction fragment as recited in claim 28, since that claim 28 is directed to a product and is not directed to a method of making a product, the patentability of claim 28 does not depend on how the product recited in claim 28 is made. It is known that the patentability of a product does not depend on its method of production. If the claim is a product-by-process claim, it is well established that even though product-by process claims are limited by and defined by the process, the determination of the patentability of the product is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 29-31, since claims 29-31 are directed to a method for making the product of claim 28, claims 29-31 are anticipated by New England Biolabs 96/97 Catalog.

Therefore, New England Biolabs 96/97 Catalog teaches all limitations recited in claims 28-31.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 28-31 have been considered but are moot in view of the new ground(s) of rejection. Although claims 28-31 in above rejections under 35 USC 102 are rejected using New England Biolabs 96/97 Catalog, since different parts of New England Biolabs 96/97 Catalog are used in the rejection and the basis of this rejection is different from the rejection made in previous office action using New England Biolabs 96/97 Catalog, this rejection is the new ground(s) of rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1634

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. No claim is allowed.

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Frank Lu  
Primary Examiner  
April 20, 2006



**FRANK LU**  
**PRIMARY EXAMINER**